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| 10/530,223   | 04/04/2005  | Gerard Francis Robinson | 42603-0400                       | 5261                   |
| 21611  | 7590        | 11/05/2007              |                                  |                        |
| SNELL & WILMER LLP (OC)<br>600 ANTON BOULEVARD<br>SUITE 1400<br>COSTA MESA, CA 92626 |             |                         | EXAMINER<br>PLUMMER, ELIZABETH A |                        |
|  |             |                         | ART UNIT<br>3635                 | PAPER NUMBER           |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/530,223

Applicant(s)

ROBINSON, GERARD FRANCIS

Examiner

Elizabeth A. Plummer

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 9, 10 and 13-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/01/2007.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's amendments and arguments received 08/01/2007 have entered and considered. Claims 18-21 have been added. An examination of pending claims 1-21 is herein presented.

#### ***Claim Objections***

1. Claims 4 and 11-17 are objected to because of the following informalities: Claims 4 and 11 recite the phrase, "from the upper limb inner face (17) the upper limb lower boundary (13), the outer limb lower face..." which appears to be missing a comma. Examiner suggests amending the phrase to read, " from the upper limb inner face (17), the upper limb lower boundary (13), the outer limb lower face..." . Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1-4, 7, 11, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sabac et al. (US Patent 6,912,817).

- a. Regarding claim 1, Sabac et al. discloses a sealing system comprising at least two parts being a longitudinal strip profile (200) and a sealing material (210), both adapted in combination to maintain a sealed joint between relatively vertical and horizontal surfaces (Fig. 2), the strip profile (200) comprising a first upper limb (222) having an upper limb upper boundary and an upper limb lower boundary between which there extends an upper limb inner face (left side of limb in Fig. 2,3,4) and an upper limb outer face, and from which upper limb inner face or upper limb boundaries there extends at least one second outer limb (202) having an outer limb inner boundary attached to the upper limb (Fig. 2,3,4) and an outer limb outer boundary between which outer limb boundaries there extends an outer limb upper face and an outer limb lower face (top and bottom faces of 202), characterized in that the longitudinal strip profile (200) is semi-flexible (column 3, lines 25-28) and the at least one second outer limb is flexible and further characterized in that there extends from the outer limb lower face at least a third flexible inner limb (206) (Fig. 2,3,4) adapted to sealing engage an uncured sealing material and to said the full or substantial isolation of the uncured sealing material from the upper limb inner face or outer limb lower face (Fig 2,3,4).
- b. Regarding claim 2, the flexibility in the strip profile is achieved through adjustment of the sectional wall thickness (column 3, lines 19-38).
- c. Regarding claim 3, the inner limb (206) forms and anchors and directly engages sealing material (210) with the horizontal surface, in substantial isolation from the remainder of the strip profile (200).

- d. Regarding claims 4 and 11, the additional inner limbs (222) extend from the upper limb inner face and filler material (220) extends from the upper limb lower boundary.
  - e. Regarding claim 7, the strip profile (200) has a flexible lip (adjacent 230, 226) along the uppermost boundary of the first upper limb and the outermost boundary of the second outer limb capable of engaging irregular vertical and horizontal surface respectively.
  - f. Regarding claim 20, the third flexible inner limb (206) is inherently connected to the second outer limb (202) by a co-extruding flexible material because the longitudinal strip is extruded (column 2, lines 15-16) and capable of being flexible (column 3, lines 19-28).
4. Claims 1, and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Schluter (US Patent 4,829,731).
- a. Regarding claim 1, Schluter discloses a sealing system (Fig. 2) comprising of at least two parts being a longitudinal strip profile (1) and a sealing material (17), both adapted in combination to maintain a sealed joint between relatively vertical and horizontal surfaces (Fig. 2), the strip profile comprising a first upper limb (11) having an upper limb upper boundary and an upper limb lower boundary between which there extends an upper limb inner face and an upper limb outer face (Fig. 2), and from which upper limb inner face there extends at least one second outer limb (12,13) having an outer limb inner boundary attached to the upper limb (11) and an outer limb outer boundary between which

outer limb boundaries there extends an outer limb upper face and an outer limb lower face characterized in that the longitudinal strip profile is semi-flexible (ie. has flexible parts) and the at least one second outer limb is flexible (13) and further characterized in that there extends from the outer limb lower face at least a third flexible inner limb (14) adapted to sealingly engage an uncured sealing material (17) and to aid the full or substantial isolation of the uncured sealing material from the upper limb inner face and outer limb lower face.

b. Regarding claim 18, the third flexible inner limb is connected to the first upper limb by a first co-extruding flexible material (15).

c. Regarding claim 19, the third flexible inner limb is inherently connected to the second outer limb by a second co-extruding flexible material, as the inner limb and outer limb are continuous and an extruded plastic (column 3, lines 5-7).

d. Regarding claim 20, the third flexible inner limb is inherently connected to the second outer limb by a co-extruding flexible material, as the inner limb and outer limb are continuous and an extruded plastic (column 3, lines 5-7).

e. Regarding claim 21, a fourth limb is connected to the first upper limb forming a chamber (Fig. 2) wherein the third flexible inner limb can engage the fourth limb at the chamber (via 15).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sabac et al. (US Patent 6,912,817) in view of Robinson (GB 2348805). Regarding claim 6, Sabac et al. discloses the invention as claimed except for the outer limb upper face being adapted to throw off water over the complementary sealing material. However, it is notoriously well known in the art that outer limbs can be adapted to throw off water in order to create a better seal. For example, Robinson teaches a longitudinal strip (10) and a sealing material (30), both adapted to maintain a sealed joint between typically relatively vertical and horizontal surfaces, and comprising a outer limb which has an outer limb upper face adapted to throw off water over the complementary sealing material (Fig. 1,2; page 2, lines 6-7) in order to create a stronger seal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sabac et al. to have an outer limb face adapted to throw off water, such as taught by Robinson, in order to create a more effective seal.

7. Claims 1, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson (GB 2348805) in view of Sabac et al. (US Patent 6,912,817).

a. Regarding claim 1, Robinson discloses a sealing system comprising at least two parts being a longitudinal strip profile (10) and a sealing material (30), both adapted to maintain a sealed joint between typically relatively vertical and horizontal surfaces, the strip profile (10) comprising a first upper limb (11) having an upper limb upper boundary (12) and an upper limb lower boundary (13)

between where there extends an upper limb inner face (15) and an upper limb outer face (14), and from which upper limb inner face there extends at least one second outer limb (19) having an outer limb inner boundary attached to the upper limb and an outer limb outer boundary between which outer limb boundaries there extends an out limb upper face and an outer limb lower face, and further characterized in that there extends from the upper limb inner face at least a third inner limb (25) adapted to sealingly engage an uncured sealing material (30) to aid the substantial isolation of the uncured sealing material from the upper limb inner face (Fig. 1,2). While Robinson teaches that the upper limb is rigid, Robinson is silent on whether the second outer limb and third inner limb are flexible. However, it is notoriously well known in the art that flexible limbs can create a more dynamic seal. For example, Sabac et al. teaches a sealing system which rigid limbs can be replaced with more flexible limbs (column 3, lines 20-29) in order to better dissipate major instantaneous force. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Robinson to have flexible inner and outer limbs, such as taught by Sabac et al. in order to create a seal better suited to withstand instantaneous forces.

b. Regarding claim 5, the strip profile in contact with the sealing material at the interface between the strip and the horizontal and vertical surfaces has a plurality of ribs or recesses to contact and grip a sealing material or an adhesive material (page 2, lines 1-5).



c. Regarding claim 8, the height of the first upper limb is reduced through the use of the provision of at least one score line, allowing the easy tearing off of a longitudinal section of the strip (page 2, lines 17-18).

***Allowable Subject Matter***

8. Claims 9-10, 13-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Plummer whose telephone number is (571) 272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/JEANETTE CHAPMAN/  
PRIMARY EXAMINER

EAP  
GAR